

REMARKS

This Response is submitted in reply to the Office Action mailed on February 6, 2007. Claims 40, 41, 45, 61 to 63, 65 and 71 have been amended. Certain of these claims have been amended to correct minor informalities. No new matter is added by these amendments.

A Request for Continued Examination is submitted herewith. Please charge deposit account number 02-1818 for any fees which are due in connection with this Response.

The Office Action rejected Claim 71 under 35 U.S.C. § 112, second paragraph, for failing to provide sufficient antecedent basis for the element "the symbols." Applicants have amended Claim 71 to change the phrase "the symbols" to "the numbers," as recommended by the Office Action. Accordingly, Applicants respectfully submit that this rejection has been overcome.

The Office Action rejected Claims 1 to 71 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,988,732 to Vancura ("Vancura") in view of "The Price is Right" pricing game "Bullseye 1" ("Bullseye"). Applicants respectfully disagree with these rejections for at least the reasons discussed below.

Vancura provides a knowledge-based bonus game wherein a player's expected return is set not to exceed an amount that maintains an acceptable house advantage to the casino (Col. 4, lines 11 to 14). In one embodiment, the knowledge-based game is a modified version of one of the known "The Price Is Right" games. In this embodiment, the gaming device shows the player an object and displays or provides a written and/or verbal description of the object. After displaying the object and providing its description, the gaming device displays three possible prices for that object, and the player has two chances to guess which of the prices is the correct price for the object (Col. 10, lines 10 to 12). If the player guesses the correct price on the first try, the player receives a high payout, such as 54 coins (Col. 12, lines 10 to 11). If the player guesses the correct price on the second try, the player receives a lower payout, such as 42 coins (Col. 12, lines 13 to 14). The gaming device provides the lowest payout, such as an award of 30 coins, if the player misses with both guesses (Col. 12, lines 14 to 15).

Bullseye discloses a game in which a player must guess the correct price of an item. The player has seven tries to guess the correct price. The game does not show the player a group of possible prices from which the player can choose a number for the player's guess. Rather, the player must come up with a number that the player thinks is the correct price for the item. After the player makes a guess, a host tells the player whether the actual price of the item is higher or lower than the player's guess.

On page 4 of the Office Action, the Office Action admits that Vancura does not disclose a relationship indicator. The Office Action concludes that it would have been obvious to modify Vancura to include a relationship indicator, as taught by Bullseye, since Vancura teaches the use of "The Price Is Right" games.

As discussed above, Vancura discloses a modified "The Price Is Right" game for use as a bonus game after a player plays an underlying base game. Vancura provides no reason for further modifying the already modified "Price Is Right" bonus game to include relationship indicators, as proposed by the Office Action. There is no reason to make such modification to Vancura.

Applicants respectfully submit that altering Vancura in the manner suggested by the Office Action relies on improper hindsight. To form the basis for the obviousness rejection, the Office Action improperly uses hindsight reasoning by combining two references that render the primary reference unsatisfactory for its intended purpose. Obviousness cannot be based on the hindsight combination of components selectively culled from prior art to fit the parameters of the claimed invention. See *ATD Corp. v. Lydall*, 48 U.S.P.Q.2d 1321, 1329 (Fed. Cir. 1998).

Moreover, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. Incorporating relationship indicators into the game of Vancura would render Vancura unsatisfactory for its intended purpose of providing a knowledge-based bonus game which maintains an acceptable house advantage. As discussed above, Vancura provides a player with two chances to pick a target price from three possible prices. If Vancura were modified to include a relationship indicator for indicating whether the target price is higher or lower than a guessed price, even players with no knowledge would always win. In such a variation

of the Vancura game, every player would use the first pick to choose the middle price, and the relationship indicator would subsequently direct the player to the target price. Accordingly, modifying Vancura to include relationship indicators and thus enabling all players (regardless of their knowledge levels) to win in each play of the game renders Vancura inoperable for its intended purpose and is, therefore, an improper basis for the obviousness rejection.

In addition, Vancura teaches away from the inclusion of a relationship indicator wherein, after each time the player selects any one of the selectable symbols using the symbol selector which is not the target symbol and not a last selection, the relationship indicator identifies:

- (a) a relationship in the secondary game between the target symbol and the selected symbol, including
- (b) a subset of selectable symbols of the target set which includes at least the target symbol and enables the player to select the target symbol with a next selection in the subset.

As discussed above, Vancura discloses displaying the object and a description of the object to a player and subsequently enabling the player to make selections from the group of possible prices. By showing the player the object and its description, Vancura provides a way to assist players in determining which of the possible prices best corresponds to the displayed object. However, Vancura provides this indication or hint prior to enabling the player to make guesses, and not after a guess. Therefore, a person of ordinary skill in the art would not modify Vancura to include a relationship indicator wherein, after each time the player selects any one of the selectable symbols using the symbol selector which is not the target symbol and not a last selection, the relationship indicator identifies:

- (a) a relationship in the secondary game between the target symbol and the selected symbol, including
- (b) a subset of selectable symbols of the target set which includes at least the target symbol and enables the player to select the target symbol with a next selection in the subset.

Accordingly, for at least the reasons discussed above, Applicants respectfully submit that amended independent Claim 1 and the claims depending therefrom are each patentably distinguished over Vancura and Bullseye.

Independent Claims 17, 27, 33, 40, 43, 45, 47, 49, 54, 61, and 65 are each directed to a gaming device/method of operating a gaming device which includes certain similar elements to amended independent Claim 1. For the reasons discussed above with respect to amended independent Claim 1, Applicants respectfully submit that independent Claims 17, 27, 33, 40, 43, 45, 47, 49, 54, 61, and 65 and the claims depending therefrom are each patentably distinguished over Vancura and Bullseye and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and, in the absence of more pertinent art, such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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BY  _____

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Dated: May 7, 2007